

**REMARKS/ARGUMENTS**

The Advisory Action mailed June 9, 2005 has been carefully considered.

Reconsideration in view of the following remarks is respectfully requested.

**Claim Status and Amendment to the Claims**

Claims 12-33 are pending, with Claims 12, 19, 26 and 30 being the independent claims. Claims 12-24, 26-27 and 30-31 stand rejected. Claims 25, 28-29 and 32-33 stand objected to.

In the forgoing Amendments, Applicants have amended Claims 12, 19, 26 and 30, and canceled Claims 25, 29 and 30 without prejudice to or disclaimer of the subject matter therein. Support for these amendments can be found in the specification and claims of the application as filed. No new matter has been added by these amendments. Claims 12-24, 26-28, 30-31 and 33 remain pending in the application. Applicants respectfully request entry of the foregoing Amendments and reconsideration of the present application in light of the amendments above and the remarks below.

Claim 12 has been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Applicants thank the Examiner for the indication of allowability of Claims 25, 28-29 and 32-33 if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Claim 19, 26 and 30 have been amended to explicitly incorporate all of the limitations of Claim 25, 29 and 32, respectively. Therefore, Claims 19, 26 and 30 are in the condition for allowance. Based at least on their dependence on independent Claims 19, 26 and 30, dependent Claims 20-24, 27-28, 31 and 33 are

allowable as well. Applicants respectfully request the withdrawal of the rejection of these claims.

### Support for Amendments

The amendment to claim 12 is supported by the original specification, page 15, lines 21- page 16, line 3.

### The 35 U.S.C. § 102 Rejection

Claims 12, 26 and 30 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Tsuchihashi et al. (US 4,955,654) ("Tsuchihashi"). Without admitting that Tsuchihashi is prior art and reserving the right to establish that it is not prior art, Applicants respectfully submit that this rejection is traversed for the reasons below.

According to the M.P.E.P., a claim is anticipated under 35 U.S.C. § 102(a), (b) and (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>1</sup>

In the Advisory Action, the Examiner contends as follows:

[A]lthough the Applicant argues that the force feedback is a physical force applied as opposed to the control signal force feedback in the cited reference (Tsuchihashi), claim 12 actually recites the limitation that "the force feedback being based on control signals associated with detected movement of the peripheral device." This limitation does not present a physical force as force feedback, but rather a force feedback that is a control signal generated as a result of the movement of the peripheral device. This limitation is found in the cited reference.

<sup>1</sup> Manual of Patent Examining Procedure (MPEP) § 2131. See also *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants respectively submit that Tsuchihashi fails to disclose an apparatus having a capture mechanism having a coupling mechanism and being configured to engage a user manipulatable peripheral device physically contacted by a user.

In one aspect, an actuator is disposed within the apparatus (interface device) to provide force feedback to the peripheral device (an instrument). See abstract of the present invention. An advantage of the present invention is to enable, via an interface device, realistic simulation of the forces encountered during an actual medical procedure by a user manipulating various peripherals. See summary of the application.

In contrast, the feedback disclosed by Tsuchihashi is used to prevent an excessive force from acting upon an end effector while the end effector captures an object in outer space. See col. 1, lines 6-10 and 50-56 of Tsuchihashi. Tsuchihashi essentially discloses a feedback of the force sensor to control the operation of the end effector, whereas the present invention discloses physical feedback force that allows a user to feel the force via a peripheral device. As can be seen, Tsuchihashi does not disclose or suggest such physical feedback force that can be applied to a peripheral device physically contacted by a user.

At least for this reason, Tsuchihashi cannot anticipate Claim 12 under § 102. Accordingly, Applicants respectfully submit that Claim 12 is patentable over Tsuchihashi. If an independent claim is valid, the claims that depend from the independent claim should also be valid as matter of law. See Jenric/Pentron, Inc. v. Dillon Co., 205 F. 3d 1377, 1382 (Fed. Cir. 2000). Since Claims 13-18 depend from Claim 12, Claims 13-18 should also be patentable.

The Office Action further rejected Claims 26 and 30 as anticipated by Tsuchihashi under § 102. To expedite the allowance of present invention, Applicants have amended Claims 26 to incorporate the subject matter of Claim 29, which has been indicated as being allowable. As such, amended Claim 26 is now in the condition for allowance. Since Claims 27-28 depend from Claim 26, Claims 27-28 should also be in the condition for allowance.

Similarly, Claim 30 has been amended to incorporate the subject matter of Claim 32, which has been indicated as being allowable. Accordingly, the amended Claim 30 is now in condition for allowance. Since Claims 31 and 33 depend from Claim 30, Claims 31 and 33 should also be in condition for allowance.

#### **The First 35 U.S.C. § 103 Rejection**

Claims 13, 14, 19, 27 and 31 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tsuchihashi in view of Rosenberg et al. (US Pat. No. 5,805,140) ("Rosenberg") among which claim 19 is an independent claim. Without admitting that Tsuchihashi and Rosenberg are prior art and reserving the right to establish that they are not prior art, Applicants respectfully submit that this rejection is traversed for the reasons below.

In order to expedite the allowance of Claim 19, Applicants have amended Claim 19 to explicitly incorporate all of the limitations of Claim 25, which has been indicated as being allowable. Accordingly, amended Claim 19 is now in condition for allowance. Since Claims 20-24 depend from Claim 19, Claims 20-24 should also be allowable. Since Claims 13 and 14

depend from amended Claim 12, which is in condition for allowance, Claims 13 and 14 should also be allowable.

### The Second 35 U.S.C. § 103 Rejection

Claims 15-18 and 20-24 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tsuchihashi in view of Rosenberg in further view of Bailey (US Pat. No. 6,062,865). This rejection is overcome because, as discussed above, these claims depend from allowable claims.

### Request for Entry of Amendment

Entry of this Amendment will place the Application in better condition for allowance, or at the least, narrow any issues for an appeal. Accordingly, entry of this Amendment is appropriate and is respectfully requested.

### Conclusion

Based on all of the above, Applicants believe all claims now pending in the present application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

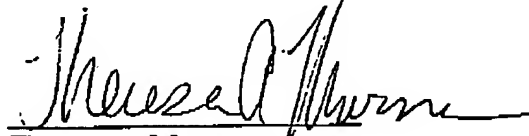
No additional fees are believed to be due at this time. However, please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Attorney Docket No.: IMMR-IMD0002C(034701-000067)

Applicants thank the Examiner for carefully examining the present application and if a telephone conference would facilitate the prosecution of this application, the Examiner is invited to contact Theresa Moorman at (408)282-1881.

Respectfully submitted,

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Dated: September 15, 2005

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